



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,889	10/01/2001	Manabu Deguchi	Q66258	3498

7590 06/27/2005

SUGHRUE MION ZINN MACPEAK & SEAS, PLLC
2100 Pennsylvania Avenue, NW
Washington, DC 20037-3213

EXAMINER

CHIANG, JACK

ART UNIT PAPER NUMBER

2642

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/965,889

Applicant(s)

DEGUCHI, MANABU

Examiner

Jack Chiang

Art Unit

2642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/26/04, 1/26/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-17, 19 and 23-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-17, 19, 23-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date 6/2/05
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

CLAIMS

1. Claims 1-13 had been canceled.

Claims 14-17, 19, 23-25 are pending.

Claims 18, 20-22, 26-30 are now canceled due to their non-elected status.

112 First Paragraph Rejection

2. Claims 14-17, 19, 23-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. See comments below.

Claims 14-17, 19, 23-25 are also rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. See comments below.

In claim 14, it claims various information items and key operation which can not be supported from the original disclosure. These items can not be selected by the claimed key operation, therefore, it is considered as unenabling and a new matter.

Art Rejection

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 14-17, 19, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Wicks et al. (US 6128475) in view of Haas (EP 0602840) and Sudo et al. (US 5987336).

Regarding claim 14, Wicks shows a display (12) and a key operation section (14-15) comprising:

A first key section (15) including to select a desired item (moving a highlighted portion to a desired information item) (col. 3, lines 54-58), and to execute the item (selecting the desired item) (col. 3, lines 59-65); and

A second key section including a ten key pad (14).

Wicks differs from the claimed invention in that the first key section is a joy-stick key instead of a selection key pad and an execution key.

However, Haas teaches providing a joy-stick key (fig. 2) and its equivalent button key having an execution key surrounding by arrow keys (fig. 4). Further, from the present

Art Unit: 2642

application (figs. 1 and 7), it also shows the two types of keys, and there is no teaching of criticality for one type over another.

Hence, it would have been obvious for one skilled in the art to use Wicks' joy-stick key as it is, or replace the joy-stick key with the button keys as taught by Hass. This simply can be considered as a variation of Wicks because the basic operation of the key is substantially unchanged.

Wicks further differs from the claimed invention in that it does not show the row and columns information items.

However, the concept of highlighting and executing the selected item is well taught by Wicks. Further, this notorious well known information items are displayed in rows and columns, this is also taught by Sudo. Sudo also shows the highlighting and executing (calling) a selected phone number (col. 10, lines 43-53 in Sudo).

Hence, it would have been obvious for one of ordinary skill in the art to incorporate the information items shown by Sudo in Wicks, this is a well known method for storing information items, such as names and phone numbers, such that it allows the user to store and access information in the device (col. 2, lines 31-47 in Sudo).

Regarding claim 15-19, 23-25, the combination of Wicks, Haas and Sudo shows:

A housing and the keys (fig. 1 in Wicks);

Movement operation keys and their contacts (402-405 in Haas) for selecting an item;

The enter key and its contact (406 in Haas) for executing the selected item;

The single lever-type key (15 in Wicks) for selecting and executing the selecting item;

The row and columns of items and the keys (see comments in claim 14);

The calling function (the highlighting and executing/calling a selected phone number, col. 10, lines 43-53 in Sudo).

ARGUMENT

5. In response to the remarks (pages 11-14) filed 08/26/04 and 1/24/05, applicant mainly argues about the information items. With respect to this issue, a phone call was made to Mr. Raulerson (see interview summary), it is agreed that the amended portion of claim 14 has 112 problem and is difficult to evaluate this issue, see also comments above.

6. Applicant's arguments with respect to claims 14-17, 19, 23-25 have been considered but are moot in view of the new ground(s) of rejection.

7. Applicant's submission of the requirements for the joint research agreement prior art exclusion under 35 U.S.C. 103(c) on 08/26/04 and 1/24/05, prompted the new ground(s) of rejection under 37 CFR 1.109(b) presented in this Office action.

Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.02(l)(3). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any


Art Unit: 2642

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Chiang whose telephone number is 571-272-7483. The examiner can normally be reached on Mon.-Fri. from 8:00 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on 571-272-7488. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jack Chiang
Primary Examiner
Art Unit 2642